

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the the following remarks. Claim 1-16 were pending prior to the Office Action. Claims 17-18 have been added by this Reply. Therefore, claims 1-18 are pending. Claim 1, 2, 3, 4, and 5 are independent.

ALLOWABLE SUBJECT MATTER

Applicants appreciate that the Examiner has indicated claims 8, 15, and 16 define allowable subject matter.

OBJECTION TO THE SPECIFICATION

The disclosure is objected to for not including the list of claims on a separate sheet. Applicant's request to insert a new page marker between lines 13 and 14 on page 30 (see above) is believed to address this objection. Applicant respectfully request that the objection to the specification be withdrawn.

35 U.S.C. § 103 REJECTIONS

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen et al. (USPN 5,737,491) ("Allen") in view of Walker et al. (USPN 6,381,582) ("Walker"). Applicant respectfully traverses.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, claim 4 recites, *inter alia*, “confirmed order certifying means for certifying whether or not order information indicating that a requester of the image output service has confirmed the content of the output instruction is recorded in the recording medium.” *Emphasis added*. In the Office Action, it admitted that Allen does not teach or suggest this feature.

However, contrary to the assertion made in the Office Action, Walker does not cure this deficiency of Allen. Allen is directed toward system and methods for processing local payments of remotely purchased goods. See *column 1, lines 6-9*. It is asserted that Walker discloses a method of capturing electronic order information and generating an order code, otherwise known as an order confirmation number or purchase number. It is further asserted that the order confirmation number is sent to the user as confirmation that the order has been received and is stored along with the order. See *Office Action, page 2, first paragraph*.

For the sake of argument, Applicant assumes that the assertions are true. More specifically, it is assumed that the order is confirmed from the merchant to the customer. In other words, in Walker, it is the merchant or supplier of services that confirms. This is in contrast to claim 4, where it is the requester of the service who confirms. Clearly, even if the assertion is taken to be true, Walker cannot teach or suggest the above-recited feature of claim 4.

Because neither Allen nor Walker teaches or suggests at least the above-recited feature of claim 4, the combination of Allen and Walker also fails to teach or suggest the same. Therefore, claim 4 is distinguishable over the combination of Allen and Walker.

Applicant respectfully request that the rejection of claim 4, based on Allen and Walker, be withdrawn.

Claims 1-3, 5-7, and 10-12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen in view of Inoue (USPN 5,710,954) ("Inoue") in further view of Walker. Applicant respectfully traverses.

Independent claims 2, 3, and 5 recite, *inter alia*, "order certifying means for certifying an order by recording confirmed order information in the recording medium when a predetermined order confirmation indicating that the order confirmation has been completed is accepted." Independent claim 1 recites a similar feature. Again, it is admitted Allen does not teach or suggest this feature. Also, Inoue has not been, and indeed cannot be, relied upon to

correct this deficiency. Also for reasons similar to those stated above with respect to claim 4, Walker cannot be relied up on to correct this deficiency. Therefore, independent claims 1-3, and 5 are distinguishable over the combination of Allen, Inoue, and Walker.

Claims 6-7 and 10-12 depend from independent claim 5, directly or indirectly. Therefore, for at least the reasons stated with respect to claim 5, these dependent claims are also distinguishable over the combination of Allen, Inoue, and Walker.

Applicant respectfully request that the rejection of claims 1-3, 5-7 and 10-12, based on Allen, Inoue, and Walker, be withdrawn.

Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen in view of Inoue in further view of Walker and in further view of Slotznick (USPN 5,983,200) ("Slotznick"). Applicant respectfully traverses.

Claims 13 and 14 depend from independent claim 5, directly or indirectly, and claim 5 recites, *inter alia*, "order certifying means for certifying an order by recording confirmed order information in the recording medium when a predetermined order confirmation indicating that the order confirmation has been completed is accepted." It has been shown above that none of Allen, Inoue, and Walker teaches or suggests this feature. Slotznick has not been, and indeed cannot be, relied upon to correct this deficiency. As

a result, independent claim 5 is distinguishable over the combination of Allen, Inoue, Walker, and Slotznick.

Therefore, claims 13 and 14 are also distinguishable over the combination of Allen, Inoue, Walker, and Slotznick for at least the reasons stated with respect to claim 5.

Applicant respectfully request that the rejection of claims 13 and 14, based on Allen, Inoue, Walker, and Slotznick, be withdrawn.

NEW CLAIMS

Claims 17-18 have been added through this reply. All new claims are believed to be distinguishable over the cited references, individually or in any combination. These claims depend on independent claim 5 directly or indirectly and it has been shown above that claim 5 is distinguishable over the cited references. Therefore, these dependent claims are also distinguishable over the cited references for at least the reasons stated with respect to claim 5.

Applicant respectfully requests that the claims 17-18 be allowed.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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